

PATENT APPLN. NO. 10/609,022
RESPONSE UNDER 37 C.F.R. §1.111

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REMARKS

Claims 1 and 2 are rejected under the first paragraph of 35 U.S.C. § 112 as failing to comply with the description requirement. The position of the Office is that the specification does not demonstrate that at the time the application was filed, applicant contemplated applying the adhesion promoter of its invention to an opto-electronic surface of a device produced in a CMOS process.

Applicant respectfully submits that the 35 U.S.C. § 112, first paragraph, rejection is not correct. More particularly, applicant submits that the specification of the present application conveys "with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention". See *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1561 [19 USPQ2d 1111] (Fed. Cir. 1991). Stated differently, the description in the present application "clearly allow[s] persons of ordinary skill in the art to recognize that [the applicant] invented what is claimed." (citation omitted)).

There is no requirement, as suggested in the Action, that the specification state that the adhesion promoter can be applied on an opto-electronic surface of a device produced in a CMOS process. See *In re Hayes Microcomputer Prods., Inc.*, 982 F.2d 1527, 1533, 25

USPQ2d 1241, 1245 ("[The applicant] does not have to describe exactly the subject matter claimed.").

As noted in the Action, the present application includes an example of applying the adhesion promoter to an opto-electronic surface. Paragraph [0162] of the publication of the present application, US 2004/0115341, which corresponds to paragraph [0131] identified in the Action, describes that the example relates to the use adhesion promoter for forming a waveguide and then further describes: "however, the adhesion promoter can be used in a CMOS process, such as for increasing adhesion of a dielectric, for increasing adhesion of a passivation layer, or any layer such as one of a material that has adhesion problems (such as due to high hydrophobicity from fluorine or other groups in the material)". Such description, contrary to the suggestion in the Action, does not state that the adhesion promoter cannot be applied on an opto-electronic surface of a device produced in a CMOS process and does not describe an alternative to applying the adhesion promoted on an opto-electronic surface. Instead, when considered in light of the recitation in original claim 1 of a "method of adhering a coating of a polymer, metal, metalloid oxide or fluorinated derivatives thereof to an electrical or opto-electronic surface of a device produced in a CMOS process" (emphasis added), such description

would be understood by a person of ordinary skill in the art as being an indication that the adhesion promoter can also be applied on an opto-electronic surface of a device produced in a CMOS process.

Moreover, where an original claim and description of an application are not consistent, the description is considered to be defective (see MPEP § 608.01(1)).

Removal of the 35 U.S.C. § 112 rejection is respectfully requested.

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Olds (2003/0022395) in view of Kishita et al., EP 0616012. Olds is identified by the Office as disclosing a method of coating polymer, metal, metalloid oxide or fluorinated derivatives thereof to an opto-electronic surface of a device produced in a CMOS process (citing paragraph [0097]).

Applicants respectfully submit that the Office's interpretation of paragraph [0097] of Olds is not correct. In paragraph [0097], Olds describes an optoelectric component and a CMOS integrated circuit as separate examples of semiconductor component 56. For this reason alone the 35 U.S.C. § 103(a) rejection is improper and should be removed.

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The foregoing is believed to be a complete and proper response to the Office Action dated December 28, 2006, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

In the event that this paper is not considered to be timely filed, applicant hereby petitions for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,
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